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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,463	10/29/2001	Samuel H. Fleming	5038-137	1885

7590 05/04/2004

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1030 SW MORRISON STREET  
PORTLAND, OR 97205

EXAMINER
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HARLE, JENNIFER I

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/001,463

Applicant(s)

FLEMING, SAMUEL H.

Examiner

Jennifer I. Harle

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 1-27 are pending. Claims 1-27 are rejected.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4, 6-8, and 11-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kim, et al. (5,299,295).

Kim discloses a hand-held electronic checkbook apparatus that receives financial data from a user, contains electronics, a display including in touch-sensitive LCD form, keyboard, processor, printer for printing an electronic check, input/output port capable of transmitting and receiving data and the method thereof which procures the checkbook, enters data into predefined fields including payee and a numeric field and applying a signature to the electronic check after printing. See the entire patent and specifically, Abstract; Fig. 1; cols. 1-5.

Claims 1-2, 4, 6-8, 11-18, and 22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Havlovick, et al. (5,475,403).

Havlovick discloses a hand-held electronic checkbook apparatus and method that receives financial data from a user, contains electronics, a display including in touch-sensitive LCD form, keyboard, processor, printer for printing an electronic check, input/output port capable of transmitting and receiving data and the method thereof which procures the checkbook, enters data into predefined fields including payee and a numeric field and applying a signature to

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the electronic check after printing or a digital signature prior to printing, configures the electronic checkbook, has a print command, accesses remote financial data/account, has a reconcile function on the electronic check book and the ability to compare the remote balance with a balance maintained by the electronic checkbook (statement strip). See the entire patent and specifically, Abstract; Figs. 1 and 10-11; cols. 1-6 and 13-18.

Claims 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Havlovick, et al. (5,475,403).

Havlovick discloses as set forth above. Havlovick discloses that the electronic checkbook prompts the user via a display to complete various actions to be taken and the software includes the ability to allow users to enter in dates on which bills are due and the software presents through the electronic checkbook display the bills that are due and prompts the user whether or not to write a check and if the response is yes a check is written (Figs. 11; cols. 4 and 16).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 9-10, 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim, et al. (5,299,295) or Havlovick, et al. (5,475,403) in view of Don Crabb, Intuit's Pocket Quicken Carriet Benefits With It, Chicago Sun-Time, November 12, 1998, pg. 32.

Kim and/or Havlovick disclose as set forth above. However, neither Kim or Havlovick disclose that the input device is a touch-sensitive LCD or that the keyboard is simulated and rendered on a display, for operating the simulated keyboard. Kim discloses that manually recording check transaction and writing checks is time consuming and often cumbersome and when hurried individual often enter a series of disbursed checks in the check registry without calculating the checking account balance resulting in an unavailable current balance, thus increasing the likelihood of overdrawn accounts and hurried calculations compound this problem and add to reconciliation time and thus a handheld electronic checkbook was created (col. 1). Havlovick discloses that downscaling of product sizes is one of the most important considerations in the development of electronic products and the acceptability and therefore success of many products is directly dependent upon their relatively miniature size and light weight, including electronic checkbooks (cols. 1-2). Crabb discloses that Pocket Quicken, i.e. financial software that can be used in conjunction with Quicken99, and tracks and organizes multiple accounts including checks, cash, deposits, withdrawals, etc. on your Palm, i.e. acts as a checkbook, without the checkwriting function on a Palm, PDA. Palm devices have a touch-sensitive display/input device and at least as of 1999 have a tiny virtual keyboard for tapping out letters using the stylus and as it syncs to Quicken which has had Online Banking, i.e. Internet linking to financial account data maintained by a financial institution remote from a user and checkbooks with check printing and reconciliations and alerting to discrepancies and account information through the web since at least 1999.<sup>1</sup> Thus, it would have been obvious to one of

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<sup>1</sup> Asiaweek.com: Face Off: Paper Meets Palmtop, Asiaweek, June 25, 1999, pg. 1; 3Com/Palm Computing – About Palm Computing - Overview, <http://web.archive.org/web/19991013132658/palm.com/newspromo/corporate/overview.html>, archived October 13, 1999, printed April 30, 2004; Palm, Inc. – About,

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ordinary skill in the art at the time of the invention to have utilized a Palm with the Quicken features with the apparatus/method of Kim and or Havlovick for the specific reasons set forth above.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Toward Better Bill-Payment Processing (Microsoft to work with Visa Interactive to expand range to bill-payment options available to Microsoft Money Users, Bank Technology News, Vol. 9, No. 4, April 1996, pg. 10 discloses the use of pdas and their use as Money Managers with electronic bill payment.

\$1M Invested In Electronic Check Register (Personal Solutions Corp Raises Nearly \$1 Mil in Initial Round of Capitalization; Company Developing Handheld Device that Records Checks in an Electronic Register), American Banker, Vol. 163, No. 210, November 2, 1998, Pg. 18, discloses electronacheck an electronic checkbook.

Checkbooks Go Electronic (Personal Solutions Corp Introducing ElectronaCheck Handheld Device, Allowing Users to Capture Financial Transactions At Point-of-Sale), Bank Technology News, Vol. 11, No. 6, June 1998, pg. 18 discloses banks utilizing pdas in combination with checkbooks.

East Bay Company Plans to Sell Digital Checkbook (Verifone acquires 19.5% in Personal Solutions, which plans to begin commercial production of ElectronaCheck, a digital

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<http://web.archive.org/web/20000301153428/palm.com/newspromo/corporate/product.html>, archived March 11, 2000, printed April 30, 2004; About Palm Computing – Software Connection, <http://web.archive.org/web/19991104070031/palm.com/newspromo/corporate/platform.html>, archived November 4, 1999, printed April 30, 2004.

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checkbook consumers could carry around to keep tabs on the amount of money they have in the bank), Contra Costa Time, March 24, 1998, discloses production of electronacheck, a digital checkbook consumers can carry around.

Scott Cook Considers His Next Move (Intuit Inc faces numerous challenges, as some of the early Wall Street enthusiasm for the company has cooled), US Banker, Vol. 106, No. 11, November 1996, pg. 26 discloses Quicken and its abilities to print checks and keep an electronic checkbook.

In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, and because "the continual, chief complaint of inventors and their lawyers: that patent examiners are abysmal communicators, both orally and in writing,"<sup>2</sup> the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant(s) with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant(s) disagree with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>3</sup> the Examiner respectfully requests Applicant(s) *in their next response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. Failure by Applicant(s) *in their next response* to traverse the Examiner's positions and provide appropriate arguments in support thereof will be considered an admission by Applicant(s) of the

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<sup>2</sup> Sabra Chartrand, *A Bid to Overcome Patent Backlogs*, 152 N.Y. Times C2 (Sept. 23, 2002).

<sup>3</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

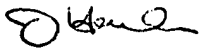
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factual determinations and legal conclusion not expressly traversed.<sup>4</sup> By addressing these issues now, matters where the Examiner and Applicant(s) agree can be eliminated allowing the Examiner and Applicant(s) to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is 703.306.2906. The examiner can normally be reached on Monday through Thursday, 6:30 am to 5:00 pm,.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703.308.5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer Ione Harle  
April 30, 2004

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<sup>4</sup> See also MPEP §714.02, 37 CFR §1.111(b), and 37 CFR §1.104(c)(3).